



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/082,677

02/25/2002

Whitney Hilton Stewart

025213-9075-00

6623

23409 7590 12/23/2008
MICHAEL BEST & FRIEDRICH LLP
100 E WISCONSIN AVENUE
Suite 3300
MILWAUKEE, WI 53202

EXAMINER

TRAN, HAI

ART UNIT

PAPER NUMBER

3694

MAIL DATE

DELIVERY MODE

12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/082,677	Applicant(s) STEWART ET AL.	
	Examiner HAI TRAN	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/18/2008 has been entered.

2. This is the communication in response to the Amendments filed on November 18, 2008 for application, titled: "Electronic Payment and Authentication System with Debit and Identification Data Verification and Electronic Check Capabilities".

3. Claims 1-47 had been cancelled. Accordingly, claims 48-76 are pending in this application.

Priority

4. This application claims the benefit of U.S. Provisional Patent Application No. 60/271,156, filed on February 23, 2001.

Response to Arguments

5. Applicant's arguments with respect to claims 48-76 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 76 is rejected under 35 U.S.C. 102(e) as being anticipated by Goeller et al. (U.S. Patent Application Publication No. 2002/0178112, provisionally filed August 14, 2000) (“Goeller”).

Examiner’s Note: Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

8. **With respect to claim 76**, Goeller discloses a method of conducting a debit validation of a consumer involved in a debit transaction, the method comprising:

receiving a request from a merchant to validate debit data of the consumer involved in a debit transaction (see Goeller, par. 49-52, Figure 3);

receiving transactional debit data that is to be validated (see Goeller, par. 54-58, Figure 5);

retrieving a consumer key based on at least a portion of the transactional debit data, the consumer key linking debit data from a plurality of data sources (see Goeller, par.56, Table 1, Figure 5/element 322);

analyzing the debit data associated with the consumer key (see Goeller, par. 61-74, Tables 4 & 5 “Response Message Fields”, “Response Codes”, Figures 6A-C); and

generating a response message to the merchant, wherein the response message is indicative of one of a first condition and a second condition, wherein the first condition is a validation of the debit data, and further wherein the second condition is a lack of validation of the debit data of the consumer (see Goeller, par. 67, Table 4 & 5, Figure 6/elements 474, 482).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 48-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goeller in view of Brown et al. (U.S Patent No. 6,026,398) (“Brown”).

11. **With respect to claim 48**, Goeller discloses a debit data validation system for a network, the system comprising:

a calling application configured to receive a request to validate debit data from a merchant, and receive transactional debit data that is to be validated (see Goeller, par. 49-52, Figure 3);

a debit data search engine including a keying module and a matching module, wherein the debit data search engine is configured to receive the transactional debit data from the calling application, and process the transactional debit data to identify a consumer key (see Brown, Abstract); and

a debit data warehouse including stored debit data, wherein the debit data warehouse is configured to retrieve the stored debit data associated with the consumer key wherein the stored debit data is representative of at least one consumer, and further wherein the consumer key links the stored debit data gathered from a plurality of data sources (see Goeller, par. 45, Figure 1/element 120. Brown, Figure 2/element 15); and

wherein the calling application is further configured to process the stored debit data, determined whether to allow the debit transaction, and generate a response message to the merchant with the determination (see Goeller, par. 67, Table 4 & 5, Figure 6/elements 474, 482).

Goeller discloses a method and system that converts paper checks online and in real-time into an electronic funds transaction, but is silent on the data searching and matching. However, Brown teaches a data processing system and method where input data is searched and matched against an index of a database. Although Brown does not disclose a specific type of data to be validated, it is noted that Brown's teachings can be applied to any type of data including the debit data and transactional debit data

Art Unit: 3694

(see Abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Goeller's invention related to online POS check service to include the data searching and matching features as taught by Brown to offer an improved system and method to customers.

12. **With respect to claims 49-53**, Goeller does not teach such features. However, Brown teaches wherein the keying module performs a keying process, and further wherein the keying process includes a standardization component, a validation component, and a matching component (see Brown, col. 10, lines 39-51 "record structure", Figures 2-6),

further comprising a converter is adapted to be coupled to at least one of the debit data search engine and the debit data warehouse (see Figure 7/elements 33 "convert"), further wherein the converter is coupled to at least one data source, and further wherein the at least one data source includes raw debit data representative of the at least one consumer (see Brown, Abstract);

wherein the converter performs parsing of the raw debit data and parsing includes breaking a single data field into a number of representative data fields (see Brown, col. 10, lines 1-11, figure 7/element 31); bursting of the raw debit data and bursting includes separating a joint account name into at least two representative names (see Brown, col. 3, lines 39-46, col. 4, figures 3-6); and including a geographic coder adapted to correct at least one of a street name, a city, a state, a zip code (see Brown, col. 4, lines 57-67, col. 9, lines 36-59 of col. 10, figures 3-6). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Goeller's

Art Unit: 3694

invention related to online POS check service to include the data searching and matching features as taught by Brown to offer an improved system and method to customers.

13. **With respect to claims 54-56**, Goeller teaches a system as claimed in claim 50, wherein the raw debit data includes data from at least one of a checking account opening, a checking account closing, a savings account opening, a savings account closing, a checking account collection, an overdraft, a check order, a returned check transaction, a check printing order, an account inquiry, a retail transaction, an ATM transaction, an automated clearinghouse transaction, and an Internet transaction (see Goeller, Table 4, par. 55 see “routing number, account number, check serial number”),

wherein the raw debit data includes attributes associated with the at least one consumer, and further wherein the attributes include at least one of a name, an address, a SSN, a driver's license number, a driver's license state, a bank account number, a home phone number, a work phone number, and an MICR (see Goeller, Table 1), and

wherein the raw debit data from the at least one data source is utilized only if it includes at least two of the attributes (see Goeller, Table 1).

14. **With respect to claim 57**, Goeller does not explicitly teach such feature.

However, Brown teaches a system as claimed in claim 49, wherein the standardization component standardizes the raw debit data into a consistent format (see Brown, col. 10, lines 39-51 “record structure”, Figures 3-6). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Goeller's invention related

Art Unit: 3694

to online POS check service to include the data searching and matching features as taught by Brown to offer an improved system and method to customers.

15. **With respect to claim 58**, Goeller does not expressly teach such feature.

However, Brown teaches a system as claimed in claim 49, wherein the validation component checks the raw debit data against existing reference files to detect at least one of bad data and incorrect data (see Brown, col. 9, lines 16-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Goeller's invention related to online POS check service to include the data searching and matching features as taught by Brown to offer an improved system and method to customers.

16. **With respect to claims 59-63**, Goeller does not teach such matching condition feature. However, Brown teaches a system as claimed in claim 49, wherein the matching component matches the raw debit data against the stored debit data to determine the first condition and second condition (see Brown, col. 3, lines 47-30 of col. 4, col. 14, lines 43-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Goeller's invention related to online POS check service to include the data searching and matching features as taught by Brown to offer an improved system and method to customers.

17. **With respect to claim 64**, Goeller does not expressly teach such features.

However, Brown teaches wherein the at least one consumer key is thirteen bytes long with the first three bytes including a partitioning key, wherein the partitioning key determines the physical partition the stored debit data the at least one consumer key is

Art Unit: 3694

representative of is located in (see Brown, Figures 13, 15, col. 16, lines 16-5 of col. 17).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Goeller's invention related to online POS check service to include the data searching and matching features as taught by Brown to offer an improved system and method to customers.

18. **With respect to claim 65**, Goeller teaches wherein the at least one consumer key is identified by at least one of a name and an address (see Goeller, Table 1).

19. **With respect to claims 66-75**, these claims correspond to claims 55-63 and have the same limitations. Hence, they are rejected under the same rationale provided in claims 55-63.

Conclusion

20. Claim 48-76 are rejected.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI TRAN whose telephone number is (571)272-7364.

The examiner can normally be reached on M-F, 9-4 PM.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 3694

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. T./
Examiner, Art Unit 3694

/Mary Cheung/
Primary Examiner, Art Unit 3694